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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

OSELE, MARK A

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 09/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/734,461

Applicant(s)

PEMBERTON ET AL.

Examiner

Mark A. Osele

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,7-15 and 42-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,7-15 and 42-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-4, 7-15, and 42-48 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The following claim amendments are all new matter not described in the original disclosure: Claim 1, lines 10-11, "each of the release layers made of a second material different than the first material,"; Claim 2, lines 3-4, "and are of sufficient width to allow removal of the strips without bending of the transfer sheet"; Claim 3, lines 1-2, "the strips are separated by a side margin indicator of a different character than the bisected release layers"; Claim 4, lines 3-4, "the transfer sheet is rigid"; Claim 7, line 5, "having substantially less rigidity than the transfer sheet" and lines 7-8, "without bending the transfer sheet"; Claim 8, lines 2-3, gaps with width greater than about 10% of the width of each of the strips"; Claim 42, line 2, "substantially rigid", Claim 46, lines 1-2, "the length of the rectangular strip is about the same size as the height of an average domestic house cat"; Claim 48, lines 1-2, "comprising a gap between each of the plurality of rectangular strips of about one

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quarter of an inch." If the new matter is deleted from the claims, the following 35 USC § 102 and 103 rejections will continue to apply.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 46 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 46 includes the limitation "about the same size as the height of an average domestic house cat," which is unclear because house cats can grow to very different sizes and because it is unclear whether "height" refers to shoulder height from the ground or the height a cat can reach when it is on its back legs scratching along a vertical surface.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 42-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Sekula. Sekula shows double sided adhesive tape releasably adhered to a corrugated substrate, 26, on the first adhesive surface, 22, and having a release layer, 28, adhered on the second adhesive surface, 24 (column 2, lines 25-34).

Regarding claim 43, Sekula teaches that the substrate can be plastic (column 3, lines 23-29.)

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3, 4, and 46-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Italian Patent 590,156 (Avery Adhesive) in view of Kriozere. Avery Adhesive shows the construction of double sided adhesive tapes, 11, on a continuous backing release layer, 20, with individual release sheets, 10, overlying the individual tapes (See Figs. 1, 3). Avery Adhesive fails to show the claimed water soluble adhesive.

Kriozere shows a rectangular adhesive strip, 12, with a release layer, 16, 18, bisected along an axis, 20, parallel to the length of the strip covering the adhesive layer, 14 (column 1, line 65 to column 2, line 6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the bisect the release layer of the references as combined because Kriozere shows that after removing one of the release layers, the edge of the remaining release layer can be used to align the the adhesive strip on an article (Figs. 1-3).

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Regarding claims 46 and 47, Kriozere teaches that it is advantageous to create strips of different lengths because they can meet different demands (column 1, lines 42-52; column 2, lines 49-54). It would have been obvious to one of ordinary skill in the art at the time the invention was made to create the strips of the references as combined of any desirable length because Kriozere shows this to be a variable determined by the end use.

Regarding claim 48, it would have been obvious to one of ordinary skill in the art at the time the invention was made to create a gap between the strips on the order of about one quarter of an inch because this dimension would allow for severing between strips or removal of the strips from the backing sheet without wasting much material.

9. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Italian Patent 590,156 (Avery Adhesive) in view of Kriozere as applied to claim 1 above, and further in view of Sato. The references as combined fail to disclose gaps between the individual double sided adhesive tapes.

Sato teaches that cutting labels on a backing sheet to create gaps between the individual labels allows for easier separation from the backing sheet than the prior art (column 5, lines 20-24; column 5, lines 68 to column 6, line 7). It would have been obvious to one of ordinary skill in the art at the time the invention was made to space the individual double sided adhesive tapes of the references as combined in the manner of Sato because Sato teaches the spacing to aid in label release. In addition, it would

have been obvious to one of ordinary skill in the art that spaced individual adhesive tapes could be more easily removed by hand.

10. Claims 7, 9, 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Italian Patent 590,156 (Avery Adhesive) in view of Anhauser et al. Avery Adhesive shows the construction of double sided adhesive tapes, 11, on a continuous backing release layer, 20, with individual release sheets, 10, overlying the individual tapes (See Figs. 1, 3). Avery Adhesive fails to show the release layer including a cut that divides the release layer into two sections.

Anhauser et al. teaches that it is known to provide linear cuts in the backing layer protecting adhesive to aid in removal of the backing material into two pieces (column 1, lines 54-60). Anhauser et al. further shows an elongate adhesive label with a lengthwise slit in the protective layer (Fig. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add a lengthwise slit in the cover layer of Avery Adhesive because Anhauser et al. teaches the value in such a slit for separating and peeling a cover sheet from an adhesive layer.

Regarding claim 9, Avery Adhesive shows the plurality of strips arranged side by side on the transfer sheet.

Regarding claim 12, Anhauser et al. shows the slit can be widthwise as well as lengthwise (See Figs. 3 and 4).

Regarding claim 13, double sided adhesive strips are typically transparent.

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11. Claims 7, 11, 13-15, and 44-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sekula in view of Anhauser et al. Sekula shows double sided adhesive tape releasably adhered to a corrugated substrate, 26, on the first adhesive surface, 22, and having a release layer, 28, adhered on the second adhesive surface, 24 (column 2, lines 25-34). Sekula fails to show the release layer including a cut that divides the release layer into two sections.

Anhauser et al. teaches that it is known to provide linear cuts in the backing layer protecting adhesive to aid in removal of the backing material into two pieces (column 1, lines 54-60). Anhauser et al. further shows an elongate adhesive label with a lengthwise slit in the protective layer (Fig. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add a lengthwise slit in the cover layer of Sekula because Anhauser et al. teaches the value in such a slit for separating and peeling a cover sheet from an adhesive layer.

Regarding claim 13, double sided adhesive strips are typically transparent.

Regarding claims 14 and 15, the strip of Sekula is substantially the same length and width as the transfer sheet.

Regarding claim 44, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a colored substrate because colored and printed substrates are commonly used for identification and advertising purposes.

12. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Italian Patent 590,156 (Avery Adhesive) in view of Anhauser et al. as applied to claim 7 above,

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and further in view of Sato. The references as combined fail to disclose gaps between the individual double sided adhesive tapes.

Sato teaches that cutting labels on a backing sheet to create gaps between the individual labels allows for easier separation from the backing sheet than the prior art (column 5, lines 20-24; column 5, lines 68 to column 6, line 7). It would have been obvious to one of ordinary skill in the art at the time the invention was made to space the individual double sided adhesive tapes of the references as combined in the manner of Sato because Sato teaches the spacing to aid in label release. In addition, it would have been obvious to one of ordinary skill in the art that spaced individual adhesive tapes could be more easily removed by hand.

13. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Italian Patent 590,156 (Avery Adhesive) in view of Anhauser et al. as applied to claim 7 above, and further in view of Patel et al. The references as combined fail to show the claimed water soluble adhesive.

Patel et al. teaches that double sided adhesive tapes with water soluble adhesive are conventional for attaching objects to fabric (column 1, lines 51-55). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use any conventional double sided adhesive tape such as the one shown by Patel et al. dependent upon the desired use of the tape.

Response to Arguments

14. Applicant's arguments with respect to claims 1-4, 7-15, and 42-48 have been considered but are moot in view of the new ground(s) of rejection.

Regarding applicant's request for proof that it would have been obvious to use any conventional double sided adhesive tape, scientific reasoning for the desirability of water soluble adhesives was included in the motivational statement for combining the Patel et al. references with the other prior art.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A. Osele whose telephone number is 571-272-1235. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Mark A. Osele', with a stylized, cursive script.

MARK A. OSELE
PRIMARY EXAMINER

August 31, 2005